

REMARKS

Double Patenting Rejections

Claims 1-38 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-9 of U.S. Patent No. 6,216,001. This rejection is respectfully traversed.

The Federal Circuit has long held that obvious-type double patenting rejections must include clear evidence to establish why an alleged variation of an invention claimed in a prior patent would have been obvious. *In re Kaplan*, 789 F.2d 1574, 229 U.S.P.Q. 683 (Fed. Cir. 1986). Hence, to establish a *prima facie* case of obvious/nonstatutory-type double patenting:

1. The Examiner must identify the inventions claimed in the claims under consideration and in the patent claims, and
2. The Examiner must establish that any variation between the inventions claimed in the claims under consideration and the earlier-issued patent claims would have been obvious to a person of ordinary skill in the art.

In addition, the Federal Circuit has held:

3. The Examiner's showing of obviousness must follow the analysis used to establish a *prima facie* case of obviousness. *See In re Longi*, 759 F.2d 887 225 U.S.P.Q. 645, 651 (Fed. Cir. 1985) The Examiner must provide *prima facie* case of obviousness for obviousness-type double patenting rejections.

In accordance with the above, the Examiner has the initial burden to show that (1) the inventions claimed (2) are not patentably distinct, and (3) are based on a *prima facie* showing of obviousness.

Applicants respectfully submit that the Examiner has failed to provide a *prima facie* case of obviousness supporting the rejection of Claims 1-38 under the judicially created doctrine of

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obviousness-type double patenting. Therefore, the Examiner's initial burden has not been met. The below examination of the Examiner's rejection of Claims 1-38 will provide the basis for this conclusion.

In rejecting Claims 1-38, the Examiner asserts that although "the conflicting claims are not identical, they are not patentably distinct from each other because they claim the methods and apparatus for determining a current service level of a wireless communication device comprising providing at least three distinct levels of service including a basic service mode, a storing service mode, and a full service mode." The foregoing is a conclusionary statement by the Examiner. The Federal Circuit has numerous times found that conclusionary statements by an Examiner, in support of an obviousness-type rejection, are insufficient to substantiate establishing a *prima facie* case of obviousness required to support the rejection.

In accordance with the above, applicants respectfully submit that the rejection of Claims 1-38 under the judicially created doctrine of obviousness-type double patenting rejection is improper and therefore should be withdrawn. In order to maintain the rejection, the Examiner must show the following in a subsequent Office Action.

First, the Examiner must identify the invention claimed. According to the Federal Circuit, this step requires that the Examiner analyze and determine if any claim in the application defines merely an obvious variation of an invention disclosed and claimed in the relied upon patent. This analysis is based on what the claim defines, and not on the claim language itself. Care must be taken that the analysis is centered on whether it would have been obvious to modify the invention claimed, not whether it would have been obvious to modify the claimed invention. Second, to establish a *prima facie* case of obviousness-type double patenting, the Examiner must show that any variations between the inventions being claimed would have been obvious to a person of ordinary skill in the art, using the test of obviousness defined in *Graham v. John Deere Co.* Failure of the Examiner to follow these steps renders the statements provided

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by the Examiner in support of an obviousness-type double patenting as legally inadequate. *In Re Kaplan*, 789 F.2d 1574, 229 U.S.P.Q. 678 (Fed. Cir. 1986)

In view of the above arguments, applicants respectfully request that the Examiner reconsider and withdraw the claim rejection under the judicially created doctrine of obviousness-double patenting.

Independent Claim 29 stands rejected under 35 U.S.C. § 101 as claiming the same invention as that of Claim 9 set forth in U.S. Patent No. 6,216,001. This rejection is respectfully traversed.

Applicants, by way of this amendment, have canceled without prejudice or disclaimer Independent Claim 29. Therefore, applicants respectfully submit that the rejection of independent Claim 29 is now moot. Accordingly, reconsideration and withdrawal of the claim rejection under 35 U.S.C. § 101 are respectfully requested.

CONCLUSION

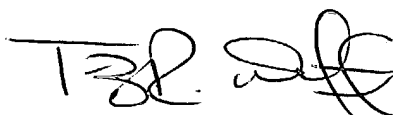
In view of the above remarks and the included deletion of Independent Claim 9, applicants respectfully submit that the instant application is in condition for allowance.

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Therefore, the Examiner is earnestly solicited to allow the instant application to issue.
Nonetheless, reconsideration and withdrawal of the claim rejections are respectfully requested.

Respectfully submitted,

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